



UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE
United States Patent and Trademark Office
Address: COMMISSIONER FOR PATENTS
P.O. Box 1450
Alexandria, Virginia 22313-1450
www.uspto.gov

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/827,657	04/05/2001	Richard E. McNutt	ODS/035	5396

1473 7590 03/05/2007
FISH & NEAVE IP GROUP
ROPES & GRAY LLP
1211 AVENUE OF THE AMERICAS
NEW YORK, NY 10036-8704

EXAMINER

BANTA, TRAVIS R

ART UNIT	PAPER NUMBER
----------	--------------

3714

SHORTENED STATUTORY PERIOD OF RESPONSE	MAIL DATE	DELIVERY MODE
3 MONTHS	03/05/2007	PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

If NO period for reply is specified above, the maximum statutory period will apply and will expire 6 MONTHS from the mailing date of this communication.

6D

Office Action Summary	Application No. 09/827,657	Applicant(s) MCNUTT ET AL.	
	Examiner Travis R. Banta	Art Unit 3714	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 13 November 2006.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-28 is/are pending in the application.
- 4a) Of the above claim(s) 2-4, 6-10, 12-14, 16-18, 20-24 and 26-28 is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1, 5, 11, 15, 19 and 25 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|---|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08)
Paper No(s)/Mail Date <u>11/13/2006</u> . | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

The Amendment filed August 7, 2006 has been received. Note that, claims 2-4, 6-10, 12-14, 16-18, 20-24, and 26-28 have been previously withdrawn due to non-elected species; and claims 1, 5, 11, 15, 19, and 25 have been examined on the merits. Currently, claims 1-28 are pending in the application. Acknowledgment has been made.

Information Disclosure Statement

The information disclosure statement (IDS) submitted on 11/13/2006 was considered by the examiner. An initialed copy is enclosed.

Claim Rejections - 35 USC § 102

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

Claims 1, 11, 15, and 25 are rejected under 35 U.S.C. 102(e) as being anticipated by Stronach (6,722,980).

Referring to claims 1 and 15, Stronach teaches a method and system for recognizing a wagerer (game player) of an interactive wagering application implemented at least partially on user equipment comprising: user equipment (wagering terminal 120, Figs.2-4; 3:54-4:57, 13:66-14:19) configured for receiving racing data from a racing data provider (110, Fig.I), wherein at least a portion of the racing data

Art Unit: 3714

originates from at least one race track where races corresponding to the racing data are being run (3:30-51; 8:23-50); allowing a wagerer to place a parimutuel wager on one of the races (4:43-57); a wagering control system configured for selecting a wagerer, and determining if the wagerer is to be recognized based on one criterion of a plurality of criteria, wherein each criterion of the plurality of criteria is associated with a different incentive; and when the wagerer is determined to be recognized based on the one criterion, providing an incentive to the wagerer (game player) (10:66-11:14). Note that, the claimed different incentive related to each criterion the are inherent the prize selection algorithm of Stronach wherein the prize is selected according to every certain amount of wager submissions, and further, payout tables maybe provided for the wager type other than the win wager type (11:5-14; 17:1-4).

Referring to claims 11 and 25, Stronach teaches providing the incentive to the wagerer comprises providing a discount on wagering service, i.e., credit is a discount (10:66-11:5).

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 5 and 19 are rejected under 35 U.S.C. 103(a) as being unpatentable over Stronach in view of Acres et al. (6,364,768).

Stronach teaches all limitations of claims 1, 11, 15, and 25 above. Stronach does not explicitly teach the limitation of determining if the to be recognized wagerer is a VIP (claims 5 and 19).

Acres et al., however, teaches a method and system for recognizing a wagerer (game player) of an interactive wagering application comprising: determining if the to be recognized wagerer is a VIP (8:35-61).

It would have been obvious to a person of ordinary skill in the art at the time of the invention was made to provide the player tracking system of Acres et al. to the interactive racing system and method of Stronach to provide a friendly interactive gambling environment to encourage frequent players to come back as well as attract new players thus increase profit.

Response to Arguments

Applicant's arguments filed 8/7/2006 have been fully considered but they are not persuasive.

The Applicant has essentially contended several different points.

1. The Examiner has not proven inherency with respect to Stronach showing the applicant's claimed feature of "determining if the wagerer is to be recognized based on one criterion of a plurality of criteria and providing the incentive associated with that one criterion to the wagerer."

2. The Examiner has "mischaracterized the prize selection algorithm of Stronach and that "the Examiner's implicit contention that there are payout tables associated with the prize selection algorithm is similarly without merit".

Art Unit: 3714

With respect to item 1, Stronarch teaches a prize selection algorithm. This algorithm as was noted in the previous action is used to determine a prize according to the particular amount of a wager submission. These can be random or associated with a pay table. A pay table is well known in the art to correlate combinations of outcomes and wagers (See column 11 lines 6-14). A player is recognized on the criterion of a wagered amount and provided an incentive based on the credits awarded or other prizes (see column 10 line 66 through column 11 line 5). While Stronarch does not specifically indicate a pay table is associating outcomes and wagers, it is inherent based on the definition of a pay table. That is to say a correlation between wager and incentive is necessarily present in the concept of a pay table. See Continental Can Co. USA v. Monsanto Co. Thus, it is deemed to be inherent that a pay table correlates a wager with an incentive. Please see also the included definition of "pay table" from <http://www.slotmachinesabc.com/terminology/termsip.html>. The rejection is respectfully maintained.

Secondly, the applicant has argued that the payout tables are not associated with the prize selection. Specifically the applicant states that "when Stronarch refers to payout tables for wager types other than the win wager type, Stronarch is referring to payout tables for the place wager type, the show wager type, the exacta wager type, the triacta wager type, etc." The examiner feels this is without consequence as pay tables are a prize selection algorithm especially as described by Stronarch column 16 line 44 through line 15 line 4. Even if Stronarch intends to reference pay tables for the place wager type, the show wager type, the exacta wager type, the triacta wager type, etc,

Art Unit: 3714

these are also prize selection algorithms. Therefore, a pay table must be associated with a prize selection algorithm because they are indeed the same.

The applicant states that wager payouts are not prizes and therefore, a pay table and a prize selection algorithm can not be the same. However, on page 4 of the Remarks, the quoted Stronarch column 10 lines 66 through column 11 line 5 for support saying "The prizes may include, for example, a credit to the users wagering account or other types of prizes". As the Applicant has cited this reference for support, the Examiner takes this to mean the Applicant admits that a prize and a payout are the same contrary to the assertion that payouts are not prizes on page 5 of the remarks.

In summary, Stronarch does teach that 1) determining if the wagerer is to be recognized based on one criterion of a plurality of criteria and providing the incentive associated with that one criterion to the wagerer and 2) that there are payout tables associated with the prize selection algorithm.

Stronarch does teach every limitation of the Applicants independent claims and the rejections are respectfully maintained.

Conclusion

THIS ACTION IS MADE FINAL. Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the

Art Unit: 3714

shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Travis R. Banta whose telephone number is (571) 272-1615. The examiner can normally be reached on Monday-Friday 9-4.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Bob Pezzuto can be reached on (571) 272-6996. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

TB

Ronald Joneau
Primary Examiner
3/2/07